

REMARKS

I. Introduction

Claims 1 to 4, 6 to 8, 10 to 34, 36 to 58 and 60 to 82 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 29 to 32, 36 to 58, 60 to 64, and 67 to 82 Under 35 U.S.C. § 103(a)

Claims 29 to 32, 36 to 58, 60 to 64, and 67 to 82 were rejected under 35 U.S.C. 103(a) as unpatentable over the combination of PCT International Patent Publication No. WO93/15648 ("Wilk et al.") and U.S. Patent No. Re. 36,434 ("Hamlin et al."). It is respectfully submitted that the combination of Wilk et al. and Hamlin et al. does not render unpatentable these claims for at least the following reasons.

As an initial matter, the Examiner will note that claim 29, for example, has been amended herein without prejudice to recite that an image capture device and a light source are mounted at a distal end of a shaft and **fluid-tightly** sealed from the environment **by the shaft** so as to be sterilizable for re-use. Claim 56 has also been amended to recite that an image capture device and a light source are mounted at a distal end of a shaft and **fluid-tightly** sealed from the environment **by the shaft** so as to be sterilizable for re-use. Support for these amendments may be found, for example, at page 2, lines 16 to 18 of the Specification.

Wilk et al. purport to describe an endoscope with a disposable insertion member. Referring to Figure 1, Wilk et al. disclose a light source 34 that is **external** to the sheath 14. As such, Wilk et al. do not disclose the sheath 14 fluid-tightly sealing the light source 34 from the environment. Referring to the arrangement illustrated in Figures 7 and 8, the light source 160 is mounted in a casing 150 that "is inserted into a chamber 162 at the distal end of a flexible endoscopic insertion member 164" where it is retained by door 166. Page 12, lines 3 to 8. To purportedly maintain sterility, the casing 15 may be inserted in a bag or envelope 174. See page 12, lines 17 to 24. In this regard, the light source and CCD 152 are sealed from the environment, if at all, in the bag or envelope 174 -- **not** the endoscope shaft. See id. As such, Wilk et al. do not disclose, or even suggest, an endoscope having an image

capture device and a light source mounted at a distal end of a shaft and **fluid-tightly** sealed from the environment **by the shaft** so as to be sterilizable for re-use.

Hamlin et al. purport to describe an endoscopic device. Referring to the Figures, light is transmitted from a light source to the lens tube 12 via a fiber optic bundle 26, which enters through the proximal end of the handle 10. See, e.g., col. 4, lines 57 to 61 and Figure 1. It is clear that the light source disclosed by Hamlin et al. is located externally to both the lens tube 12 and the removable sheath 18. In this regard, Hamlin et al. do not disclose, or even suggest, an endoscope having an image capture device and a light source mounted at a distal end of a shaft and **fluid-tightly** sealed from the environment **by the shaft** so as to be sterilizable for re-use.

As indicated above, the combination of Wilk et al. and Hamlin et al. does not disclose, or even suggest, all of the features recited in any of claims 29 and 56. As such, it is respectfully submitted that the combination of Wilk et al. and Hamlin et al. does not render unpatentable claims 29 and 56.

As for dependent claims 30 to 32, 36 to 55, 57, 58, 60 to 64 and 67 to 82, it is respectfully submitted that the combination of Wilk et al. and Hamlin et al. does not render unpatentable these dependent claims for at least the same reasons set forth above.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 1 to 4, 6 to 8, 10 to 28, 33, 34, 65, and 66 Under 35 U.S.C. § 103(a)

Claims 1 to 4, 6 to 8, 10 to 28, 33, 34, 65, and 66 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Wilk et al., Hamlin et al., and U.S. Patent No. 4,884,113 ("Kanno et al."). It is respectfully submitted that the combination of Wilk et al., Hamlin et al., and Kanno et al. does not render unpatentable these claims for at least the following reasons.

Claim 1 recites that a surgical system includes a shaft having a distal end and a proximal end. As amended herein without prejudice, claim 1 recites that an image capture device and a light source are mounted at the distal end of the shaft and **fluid-tightly** sealed from the environment **by the shaft** so as to be sterilizable

for re-use. Support for this amendment may be found, for example, at page 2, lines 16 to 18 of the Specification.

As mentioned above, claim 29, from which claims 33 and 34 ultimately depend, and 56, from which claims 65 and 66 ultimately depend, recite that an image capture device and a light source are mounted at a distal end of a shaft and **fluid-tightly** sealed from the environment **by the shaft** so as to be sterilizable for re-use.

As set forth above in support of the patentability of claims 29 and 56, the combination of Wilk et al. and Hamlin et al. does not disclose, or even suggest, an image capture device and a light source mounted at a distal end of a shaft and **fluid-tightly** sealed from the environment **by the shaft** so as to be sterilizable for re-use. Kanno et al., relating to an endoscope light source, also do not disclose, or even suggest, an image capture device and a light source mounted at a distal end of a shaft and **fluid-tightly** sealed from the environment **by the shaft** so as to be sterilizable for re-use.

As indicated above, the combination of Wilk et al., Hamlin et al., and Kanno et al. does not disclose, or even suggest, all of the features recited in any of claims 1 to 4, 6 to 8, 10 to 28, 33, 34, 65, and 66. It is therefore respectfully submitted that the combination of Wilk et al., Hamlin et al., and Kanno et al. does not render unpatentable any of claims 1 to 4, 6 to 8, 10 to 28, 33, 34, 65, and 66. Accordingly, withdrawal of this rejection is respectfully requested.

IV. Conclusion

Applicant respectfully submits that the pending claims are in condition for allowance and requests that such action be taken. If for any reason the Examiner believes that prosecution of this application would be advanced by contact with the Applicant's attorney, the Examiner is invited to contact the undersigned at the telephone number given below.

Respectfully submitted,

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